



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,456	01/19/2001	John E. Cronin	ipCG-006	8647

7590 05/27/2005
ipCAPITAL GROUP, INC.
ATTEN: RYAN K. SIMMONS
400 CORNERSTONE DRIVE
SUITE 325
WILLISTON, VT 05495

EXAMINER

MOONEYHAM, JANICE A

ART UNIT	PAPER NUMBER
----------	--------------

3629

DATE MAILED: 05/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/766,456

Applicant(s)

CRONIN, JOHN E.

Examiner

Janice A. Mooneyham

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3629

DETAILED ACTION

This is in response to the applicant's communication filed on March 18, 2005, wherein applicant elected Species A, with traverse. Claims 1-52 are currently pending in this application.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on April 18, 2001 is being considered by the examiner.

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not identify the city and either state or foreign country of residence of each inventor. The residence information may be provided on either on an application data sheet or supplemental oath or declaration.

The declaration does not identify the residence of the inventor.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-52 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it

Art Unit: 3629

pertains, or with which it is most nearly connected, to make and/or use the invention. It is not clear how to achieve the scope of the claimed invention, for example, applicant has not defined what a full range of patentable aspects are. The specification does not define or identify what the applicant means by the term "full range." The term *full range* only appears in the body of the claims and in the summary of the invention, wherein applicant identifies the invention repeating the same language as used in the body of the claims. Therefore, how would one skilled in the art know how to identify a full range of patentable aspects of an invention? How would one skilled in the art know how to iterate the steps until the full range of patentable aspects are identified, or all new invention types are exhausted, or all new life cycle aspects are covered. In the detailed description of the invention (page 9 of the specification), the applicant identifies the invention as pertaining to *a business process of interviewing potential inventions [sic] from an individual or group, and documenting these inventions in a systematic way to define the potential intellectual property space that the inventions cover* (page 9, lines 4-6). The applicant then states that *the present invention pertains to an overall scanning invention process that comprises the general steps of; (1) a training means, (2) a facilitated interaction (discussion and recording information) which starts interviewing the invention at his/her invention level, (3) a facilitation means (discussion and recording information to change the level of abstraction of the inventions, (3) a facilitated means (discussion and recording information) for changing the invention type, (5) a facilitated means (discussion and recording information) for changing the life cycle aspect, (6) a facilitated iteration means (discussion and recording information) for iterating the level of*

Art Unit: 3629

abstraction, invention type and life cycle, (7) a documentation means for capturing the invention and (8) a decision means to reduce the documented list of the invention down to a minimal group. The applicant then states that the following is a specific embodiment of each of the above-described steps, wherein the applicant identifies (1) *a training means, (2) a facilitation means for interviewing the inventor, (3) changing the level of abstraction (4) a facilitated means for changing the invention type wherein a facilitator asks questions, (5) a facilitated iteration means for iterating the level of abstraction, invention type and life cycle where applicant states that the facilitator interviews the invention [sic] by systematically changing the level of abstraction, the invention type and the life cycle (page 17, lines 5-23).* It is on page 17 (lines 9-11) that applicant claims to identify numerous ways to iterate through the steps and states the steps include the following: *(a) defining the starting level of abstraction, defining the invention type, and defining the life cycle (b) modifying the level of abstraction by holding constant the invention type and the life cycle and (c) iterating steps (a) and (b) until all levels of abstraction are exhausted.* In the body of the claims, applicant also claims a step of modifying the aspect. How does one modify the aspect? If you modify the aspect and then keep reiterating, how does one skilled in the art know when a full range of patentable aspects of the invention has been identified? It is not clear how one identifies a full range of patentable aspects of an invention by carrying out the iterating step. Thus, it would require undue experimentation for one skilled in the art to make or use the invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 2-19 depend on claim 1, claims 9-12 and 20 depend on claim 8, claims 14-17 and 21 depend on claim 13, claims 23-28 depend on claim 22, claims 30-34 depend on claim 29, claims 36-43 depend on claim 35, and claims 45-52 depend on claim 44

As to Claims 1, 8, 13, 22, 29, 35, and 44, it is not clear how to achieve the scope of the claimed invention. Applicant has not defined not defined the term "full range" nor what a "full range of patentable aspects" are. It is unclear how the steps in the invention ensure patentability.

The terms broad and narrow aspects have not been defined.

It is unclear how "why" questions lead to broad aspects and "how" questions lead to narrow aspects.

It is unclear what the relationship of the elements of the steps are. How does modifying the first aspect of the invention while holding the invention type and life cycle aspect identify a full range of patentable aspects.

Claims 1-52 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph. Considerable speculation as to the meaning of

Art Unit: 3629

the terms employed and assumption as to the scope of the claims would have to be made by the Examiner to form a basis of a prior search and rejection. See in *re Steele, Mills, and Leis*, 134 USPQ 292) wherein the court stated:

Our analysis of the claims indicates that considerable speculation as to meaning of the terms employed and assumptions as to the scope of such claims were made by the examiner and the board. We do not think a rejection under 35 U.S.C. 103 should be based on speculations and assumptions. Therefore, prior art has not been applied.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-52 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory

Art Unit: 3629

subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 1-52 only recite an abstract idea. The recited steps of merely defining an aspect of an invention and modifying the aspect does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to identify a patentable aspect. There is no positive recitation of technology in the body of the claims.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. The applicant's invention lacks concreteness because it does not produce a reproducible result. For the same aspect, modification of the aspect could be different for each person using the invention and thus, thus each time the steps are reiterated (iterating steps), a full range of patentable aspects would be different for each person carrying out the steps. Furthermore, since the term "full range of patentable aspects" is not defined, each time the invention is used, a different result could be achieved. Therefore, there is no concrete result and thus the invention is an abstract idea.

Art Unit: 3629

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Jan Mooneyham', is positioned above the printed name.

Jan Mooneyham
Patent Examiner
Art Unit 3629